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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,020	09/05/2003	Paul Joseph McArdle	G&C 30566.255-US-U1	8147
55895 7590 04/16/2008 GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045				
EXAMINER MORRISON, JAY A				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/656,020

Applicant(s)

MCARDLE ET AL.

Examiner

JAY A. MORRISON

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Re-open Prosecution

1. In view of the Appeal Brief filed on 1/22/2008, prosecution is hereby reopened. A new ground of rejection is set forth below.

To Avoid abandonment of the application, appellant must exercise one of the following two options:

- 1) File a reply under 37 CFR 1.111 (if this office action is a non-final) or a reply under 37 CFR 1.113 (if this office action is a final); or
- 2) Request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Remarks

2. Claims 1-30 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-9, 11-19 and 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bondy et al. ('Bondy' hereinafter) (Publication Number 2002/0191219) in view of Halpert et al. ('Halpert' hereinafter) (Publication Number 2004/0225958) and further in view of Fujieda (Publication Number 2002/0083082).

As per claim 1, Bondy teaches

A computer-implemented method for defining a project comprising: (see abstract and background)

(a) obtaining a project file comprising general information regarding the project; (project, paragraph [0018])

(b) creating a directory structure for the project wherein: (set up directory structure, paragraph [0018])

(i) one or more project drawing files are organized into various folders by drawing file type of the one or more project drawing files; (stored in folders, paragraph [0019])

(ii) the one or more project drawing files are composed of either a building information model for the project or a report generated from the building information model; (template, paragraph [0020]) and

(iii) the one or more project drawing files are organized into the various folders based on the building information model or the report accordingly; (stored in repository, paragraph [0020])

(c) obtaining a companion file for each project drawing file, wherein each companion file provides information used to create the directory structure (set up directory structure and resources stored into folders in accordance with the configuration file, paragraphs [0018]-[0019]) and comprises information to link each project drawing file to the project based on the building information model or the report; (tags to identify resources, paragraph [0019]).

Bondy does not explicitly indicate "(d) displaying, in the computer graphics program on a display device, the one or more project drawing files in the various folders".

However, Halpert discloses "(d) displaying, in the computer graphics program on a display device, the one or more project drawing files in the various folders" (viewer, paragraph [0096]; figure 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bondy and Halpert because using the steps of "(d)

displaying, in the computer graphics program on a display device, the one or more project drawing files in the various folders” would have given those skilled in the art the tools give a visual representation of the project structure. This gives the user the advantage of being able to view the project structure.

Neither Bondy nor Halpert explicitly indicate

However, Fujieda discloses “in a computer graphics program” (CAD application, paragraph [0046], lines 6-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bondy, Halpert and Fujieda because using the steps of “in a computer graphics program” would have given those skilled in the art the tools to improve the invention by enabling the management of different types of CAD data. This gives the user the advantage of a single source for data management.

As per claim 2,

Bondy does not expressly show the general information is selected from a group consisting of: a project name; a project number; a project level; a project division; a first default template for a new element; a second default template for a new construct; a third default template for a new view; and a fourth default template for a new sheet.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The composition of the generation information does not change the function of the claim. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

Art Unit: 2168

patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to select various pieces of information for the general information because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 3,

Bondy does not explicitly indicate “the project drawing file comprises an extensible markup language (XML) document”.

However, Halpert discloses “the project drawing file comprises an extensible markup language (XML) document” (paragraph [104], lines 2-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bondy and Halpert because using the steps of “the project drawing file comprises an extensible markup language (XML) document” would have given those skilled in the art the tools to improve the invention by allowing the use of a standardized format. This gives the user the advantage of being able to read the data across a variety of applications.

As per claim 4, Bondy teaches

the companion file (paragraph [0019], lines 2-4).

Bondy does not explicitly indicate "comprises an extensible markup language (XML) file".

However, Halpert discloses "comprises an extensible markup language (XML) file" (paragraph [104], lines 2-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bondy and Halpert because using the steps of "comprises an extensible markup language (XML) file" would have given those skilled in the art the tools to improve the invention by allowing the use of a standardized format. This gives the user the advantage of being able to read the data across a variety of applications.

As per claim 5, Bondy teaches the various folders comprise: an elements folder for element type drawing files within the building information model; a constructs folder for construct type drawing files within the building information model; a views folder for view type drawing files for the report; and a sheets folder for sheet type drawing files for the report. (directory structure, paragraph [0019], lines 2-4; note that "for" indicates intended use; *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003) "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." Examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein"

clauses; and (C) "whereby" clauses. Therefore intended use limitations are not required to be taught, see MPEP § 2106 Section II(C), MPEP 2111.04 [R-3])

As per claim 6,

Bondy does not explicitly indicate "the element type drawing file comprises a set of geometry, wherein the set of geometry is repeated one or more times throughout a project".

However, Halpert discloses "the element type drawing file comprises a set of geometry, wherein the set of geometry is repeated one or more times throughout a project" (paragraph [0084], lines 3-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bondy and Halpert because using the steps of "the element type drawing file comprises a set of geometry, wherein the set of geometry is repeated one or more times throughout a project" would have given those skilled in the art the tools reuse work previously completed. This gives the user the advantage of saving time by reusing work.

As per claim 7,

Bondy does not expressly show the construct type drawing file comprises: an identification of geometry and data for a particular level/wing and category of the project; and one or more elements.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The data contained in the drawing file is not functionally distinguished in the claim. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place various pieces of information into a file because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 8,

Bondy does not explicitly indicate "the view type drawing file automatically assembles appropriate constructs to represent a portion of a project that has been selected based upon user specified data"

However, Halpert discloses "the view type drawing file automatically assembles appropriate constructs to represent a portion of a project that has been selected based upon user specified data" (paragraph [0092]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bondy and Halpert because using the steps of "the view type drawing file automatically assembles appropriate constructs to represent a

Art Unit: 2168

portion of a project that has been selected based upon user specified data" would have given those skilled in the art the tools to reuse work previously completed. This gives the user the advantage of saving time by reusing work.

As per claim 9, Bondy teaches

the sheet type drawing file comprises one or more views and represents a printed/plotted document. (paragraph [0039], lines 14-17)

As per claims 11-19,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-9 and are similarly rejected.

As per claims 21-29,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-9 and are similarly rejected.

5. Claims 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bondy et al. ('Bondy' hereinafter) (Publication Number 2002/0191219) in view of Halpert et al. ('Halpert' hereinafter) (Publication Number 2004/0225958) and further in view of Fujieda (Publication Number 2002/0083082) and further in view of Rappaport et al. ('Rappaport' hereinafter) (Patent Number 6,850,946).

As per claim 10,

Bondy does not explicitly indicate the obtaining a companion file further comprises: defining a category and value for project information; storing said category and value in the companion file.

However, Halpert discloses the obtaining a companion file further comprises: defining a category and value for project information; storing said category and value in the companion file (paragraph [0081]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bondy and Halpert because using the steps of the obtaining a companion file further comprises: defining a category and value for project information; storing said category and value in the companion file would have given those skilled in the art the tools to customize project information. This gives the user the advantage of having control over how a project is defined.

Neither Bondy, Halpert nor Fujieda explicitly indicate "user defined".

However, Rappaport discloses "user defined" (column 6, lines 50-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bondy, Halpert, Fujieda and Rappaport because using the steps of "user defined" would have given those skilled in the art the tools to improve the invention by allowing user customization of important information. This gives the user the advantage of more control over the content of that data.

As per claim 20,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 10 and is similarly rejected.

As per claim 30,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 10 and is similarly rejected.

Response to Arguments

6. Applicant's arguments filed 1/22/2008 have been fully considered but they are not persuasive.

With regards to Applicant's arguments regarding claims 1, 11 and 21, that Bondy in view of Halpert does not disclose obtaining a project, creating a directory structure where the files are organized into various folders based on the file content, and a companion file for the project where this file has information used to create the directory structure and link the respective files to the project, it is respectfully noted that Bondy discloses all of these limitations (paragraphs [0018]-[0020]). First and foremost, it must be understood that the contents of the files themselves is immaterial since the data is not made functional in the claims and is just treated as any other type of data (see non-functional descriptive material, MPEP 2106.01 [R-5]). Therefore, in view of this, Bondy discloses a project (paragraph [0018], lines 1-5), creating a directory structure where

files are organized into various folders based on file content (paragraph [0018], lines 12-18 and paragraph [0019], lines 1-8), and a companion file for the project where this file has information used to create a directory structure and link respective files to the project (companion file with metadata tags to identify resources, paragraph [0019], lines 1-8).

With regards to Applicant's arguments concerning claims 5, 15 and 25, that Bondy does not disclose various directories, it is respectfully submitted that not only is the contents of the various folders non-functional, it is also submitted that the "for" statement in each of the folder descriptions indicates the intended use of the data inside of that directory. As noted in the rejections above, the intended use is not required to be taught although it is nonfunctional regardless.

With regards to Applicant's argument concerning claim 6, 16 and 26, that Bondy in view of Halpert does not disclose that a structure can be repeated within the project, it is respectfully noted that Halpert discloses that a structure can be imported into a matching structure (paragraph [0084]). The geometry is simply data since the functionality of the repeating of these element is not clear, so the importing or repeating of an element is therefore taught by Halpert.

With regards to Applicant's argument concerning claim 8, 18 and 28, that Bondy in view of Halpert does not disclose that the view type drawing file automatically assembles appropriate constructs to represent a portion of a project that has been selected based upon user specified data, it is respectfully noted that Halpert discloses processing a project data file selected by a user, using the appropriate processing type

for the file (paragraph [0092]). Again, the claim can be interpreted as directed towards most any type of data, and therefore Halpert discloses the limitation.

With regards to Applicant's argument concerning claim 9, 19 and 29, that Bondy does not disclose the sheet type drawing file comprises one or more views and represents a printed/plotted document, it is respectfully noted that Bondy discloses layouts and images that represent catalogs which can be delivered for printing (paragraph [0039]), which represent the claimed views which represent a printed/plotted document. Therefore Bondy discloses the limitation.

With respect to the remaining arguments Applicant's arguments with respect to claims 1-4, 7, 10-14, 17, 20-24, 27 and 30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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